

R E M A R K S

Claims 1 to 4, 6, 7, 9 to 12 and 14 to 22 as set forth in Appendix I of this paper are herewith presented for further prosecution. Relative to the version of claims preciously before the Examiner, Claims 16, 17 and 18 have been amended, and Claims 19 to 22 have been added, as indicated in the listing of the claims.

More specifically, Claims 16 to 18 have been amended to remove any plants which may be considered to fall within the realm of fruit trees. Claim 19 has been added to further bring out a certain group of the compositions delineated in Claim 17, and Claims 20 to 22 have been added to bring out those embodiments of the methods and compositions of Claims 1, 7 and 10 wherein the plants are grapevines or hops. No new matter has been added.

The Examiner reiterated the position that the subject matter of Claims 1, 2, 4, 7, 10 to 12 and 15 to 18 was unpatentable under 35 U.S.C. §103(a) in light of the teaching of *Motojima et al.* (US 4,866,201). In particular, the Examiner stated that the reference "suggests a method of regulating the growth of orchards comprising applying to the orchards (...) a composition comprising instant compounds of formula I,"²⁾ that the authors "teach orchards broadly which encompass the specific orchards of the claims,"³⁾ and that the reference "teaches the application of the chemical to foliage which would include orchard foliage."⁴⁾

As concerns Claims 16 to 18, as well as the claims newly presented with this paper, applicants respectfully note that none of the plants recited in the claims can be deemed to fall within the realm of fruit trees. As such, the Examiner's reasons for rejecting applicants' claims are not, or are no longer, applicable. The subject matter of Claims 16 to 22 is therefore deemed to be patentable in light of the teaching of *Motojima et al.* and withdrawal of the rejection of Claims 16 to 18 is respectfully solicited.

As concerns Claims 1, 2, 4, 7, 10 to 12 and 15 applicants respectfully reiterate the comments and explanations presented with their papers dated June 26 and August 20, 2008, which are herewith

2) Office action page 2, lines 13 to 15.

3) Office action page 4, lines 8 and 9.

4) Office action page 4, lines 13 and 14.

incorporated by reference. While the reference mentions the utilization of certain growth regulating compounds in orchards, applicants respectfully disagree with the Examiner's interpretation that the treatment can be deemed to be directed at fruit trees grown in an orchard, or that the foliage treatment which is mentioned by the authors may reasonably be considered to suggest a treatment of foliage of fruit trees grown in an orchard.

Where *Motojima et al.* refer to the utilization of the compounds in connection with orchards, the reference specifically states:⁵⁾

The compound of the invention which exhibits the above-mentioned plant-growth regulating effects are [sic] very useful not only for agricultural and horticultural treatment but also for control of plant growth in non-crop lands. For instance, when the compound of this invention is applied onto lawns in park, playing field, golf link, airport or embankment or undergrowth grasses in orchard or pasture land, it is possible to inhibit the overluxuriant growth, to reduce the number of reaping and/or to facilitate the mowing operations as usually required for maintenance. Further, application of the new compound of this invention onto swards can promote sideshooting and increase the planting density of swards.

It is deemed to be highly significant that the authors mention the control of undergrowth grasses in orchards as illustrative for the control of plant growth in *non-crop lands*. Also notably, the authors specifically provide that the compound is applied onto said undergrowth grasses. The Examiner's position that the reference "suggests a method of regulating the growth of orchards comprising applying to the orchards (fruit trees) a composition ..." is therefore deemed without proper basis in the teaching of *Motojima et al.*

Similarly, while the reference mentions that the compounds may be applied by foliage and/or soil treatment,⁶⁾ the paragraph cited in the foregoing clearly states that the requisite compounds is to be applied onto the undergrowth grasses, i.e., non-crop areas, rather than the orchards per se as the Examiner would have it.

The Examiner's statement "at column 20, lines 20 to 37, *Motojima et al* teaches the application of the chemical to foliage which would include orchard foliage" is also deemed to reflect an erroneous in-

5) Col. 20, indicated lines 50 to 63, of *US 4,866,201*, emphasis added.

6) E.g., col. 20, indicated lines 33 and 34, of *US 4,866,201*, references by the Examiner in this context.

terpretation of the reference. The respective section reads (*emphasis added*):

The new compounds (including the salts) of this invention can control internode elongation of cereals and prevent or reduce lodging of rice, wheat, barley, maize and the other crop-plants by foliage and/or soil-treatment. Application of the compound of this invention to seedlings of aquatic rice and growing vegetables can lead an improvement in quality, rooting after transplanting, and resistance to low temperature.

It is deemed to be immediately apparent from the emphasized part of the paragraph that the manner of treatment pertains to the control of internode elongation of cereals and the prevention or reduction of lodging of certain plants. It is well known in the pertinent art that lodging is a problem exclusively encountered in cereals and other grass-like crop plants. As such, a person of ordinary skill in the art would not reasonably consider fruit trees to fall within the realm of "the other crop-plants" which are mentioned by the authors in this context.

On the basis of the paragraphs recited in the foregoing the Examiner concluded that the reference "would have made it obvious to apply the chemical to the foliage of any plant including the orchard plants in order to regulate their growth."⁷⁾ The Examiner's conclusion is not deemed to be fairly based on what the reference reasonably conveys to a person of ordinary skill in the pertinent art. Again, *Motojima et al.* specifically refer to an application of the chemical onto undergrowth grasses in orchards rather than the application to the orchard per se. Also, the effects associated with the treatment of undergrowth grasses in orchard, i.e., *inhibiting an overluxuriant growth, reducing the number of reaping and/or facilitating the mowing operations* cannot be deemed to motivate a person of ordinary skill to apply the chemical onto fruit trees.

Therefore, and for the reasons already presented in applicants' previous papers, it is respectfully urged that the teaching of *Motojima et al.* cannot be deemed to support the Examiner's position that the subject matter of applicants' Claims 1, 2, 4, 7, 10 to 12 and 15 is unpatentable under Section 103(a). Favorable reconsideration and withdrawal of the rejection is respectfully solicited.

⁷⁾ Office action page 4, lines 14 to 16.